

REMARKS

Upon entry of the present amendment, claims 1 and 19 will have been amended to further clarify the features of the present invention. These amendments are intended merely to clarify features of Applicant's invention but are not submitted to be necessary for patentability of the claims over the combination of references cited by the Examiner.

In the outstanding Official Action, the Examiner rejected claims 1-5, 7, 8, 10-17, 19, 20 and 22-25 under 35 U.S.C. § 103 as unpatentable over MARUCCI et al. (U.S. Patent No. 6,582,451) in view of SCHMALTZ et al. (U.S. Patent No. 6,050,996) and further in view of SLATER et al. (U.S. Patent No. 5,482,054). Applicant respectfully traverses the above rejection and submits that it is inappropriate. In particular, Applicant submits that the references, even if combined as proposed by the Examiner, do not teach or render obvious the combination of features recited in Applicant's claims. In addition, Applicant submits that the Examiner has not set forth a proper motivation for the proposed combination.

In setting forth the rejection, the Examiner asserts that MARUCCI et al. "neglects to expressly disclose" manipulation members comprising electrodes and dual purpose electrical conductors. In addition to MARUCCI et al.'s neglecting to "expressly disclose", Applicant submits that MARUCCI et al. does not in any manner disclose such manipulation members, expressly, implicitly or otherwise.

Nor does MARUCCI et al. in any manner disclose manipulation members that comprise a pair of electrodes. Rather, MARUCCI et al. merely discloses that the jaws "may act as platforms for diagnostic or therapeutic modalities". In other words, the jaw members of MARUCCI et al., even as broadened by this disclosure, are not (i.e., do not comprise) electrodes but merely comprise platforms, i.e., supports, for such modalities as recited thereafter. Thus, there is no

teaching in MARUCCI et al. for manipulation members which comprise electrodes, but there is a clear teaching that the jaws are not electrodes. Moreover, both of the jaw members of MARUCCI et al. are movable by a single actuation member. This is an integral and inherent feature of the MARUCCI et al. device.

Recognizing the above and other shortcomings of MARUCCI et al., the Examiner proposes to modify the disclosure thereof in view of the teachings of SCHMALTZ et al. and SLATER et al. However, SCHMALTZ et al., as the Examiner admits, is directed to a forceps. However, it is not clear why the Examiner concludes that the forceps of SCHMALTZ et al. is "analogous" to the instrument of MARUCCI et al. which is "adopted for incorporation into a minimally evasive grasper 40 as illustrated in Fig. 6" (column 14). Clearly, the electrosurgical instrument of SCHMALTZ et al. which is, as the Examiner admits, essentially a forceps, is not so adapted. Thus, there is absolutely no reason, motivation or suggestion for one of ordinary skill in the art to combine the features of these two references.

Additionally, the wires 26, 27 that are connected to the electrodes of SCHMALTZ et al. are bundled together along one of the members from the proximal end 18 to the pivot 15 and are then separated and connected to each of the electrodes. Thus, the arrangement, structure and configuration of the wires of SCHMALTZ et al. does not render them susceptible to manipulation of jaw members. For this additional reason, there is no teaching, suggestion or motivation for the Examiner's proposed combination.

Of course, since the combination of MARUCCI et al. and SCHMALTZ et al. still does not meet the terms of the claims, the Examiner is forced to combine the same with the teachings of SLATER et al. However, SLATER et al. also discloses a structure that is not analogous to those of MARUCCI et al. and SCHMALTZ et al. In particular, the wires of SLATER et al. are

actuated by axial displacement of the spool 19. This is inconsistent with the operational method of the only other cited reference that discloses electrodes (SCHMALTZ et al.).

Moreover, in setting forth the combination, the Examiner asserts that it would be a “design expedient” to utilize the jaw manipulation members as electrodes and to use dual purpose electrical connections. However, the mere assertion of “design expedient” does not render a combination obvious or properly motivated as is required for all combinations under 35 U.S.C. § 103.

Further, the Examiner has set forth no logical basis for modifying MARUCCI et al. to utilize two actuators, instead of the single actuator disclosed therein.

The Examiner asserts that the motivation for the combination would be to create a device capable of performing through electrodes, its disclosed intended use and to provide an additional function to electrical conductors. However, the motivation set forth by the Examiner does not in any manner flow from the prior art. In other words, no cited prior art disclosure suggests making the claimed combination.

In this regard, the Examiner is reminded that the motivation or suggestion must be found in the prior art and not in Applicant’s disclosure. In this regard, attention is respectfully directed to *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991). Neither MARUCCI et al., SLATER et al. nor SCHMALTZ et al. provides such motivations or suggestions. Moreover, even if MARUCCI et al. could be combined with the teachings of SCHMALTZ et al. and SLATER et al., the mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In this regard, the Examiner’s attention is respectfully directed to *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990).

For each of the above-noted reasons and certainly for all of the above-noted reasons, it is respectfully submitted that the Examiner's combination is inadequate and insufficient to render unpatentable the combination of features recited at least in Applicant's independent claims 1 and 19.

Moreover, according to the presently submitted amendment, the claims have been amended recite (using as an example the recitations of claim 1) that "one of the leads being connected to a positive terminal of said high frequency power supply and the other of the leads being connected to a negative terminal of said high frequency power supply". In the respective claimed combinations, none of the references disclose this additional feature.

Moreover, Applicant's various dependent claims are submitted to be clearly patentable over the cited combination of references based on their own recitations as well as based upon their dependence from a shown to be allowable independent claim.

In this regard, Applicant notes that the Examiner has not in any manner treated the recitations of Applicant's claims 14,15 and 22-25. If the Examiner persists in maintaining the outstanding rejection, the Examiner is respectfully requested to point out exactly where in the combination of references the recitations of at least these dependent claims are found.

SUMMARY AND CONCLUSION

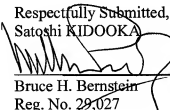
Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the claims and has pointed out a basis for the patentability of the claims based on the shortcomings of the references as well as the lack of motivation for the claimed combination. Applicant has further noted that the newly recited feature in the claimed combinations is not taught, disclosed or rendered obvious by any of the references cited by the Examiner.

Applicant notes that the status of the present application is after final rejection but nevertheless submits that entry of the present amendment is appropriate in accordance with the provisions of 37 C.F.R. § 1.116. In particular, the amendment to the claims does not raise new issues requiring further consideration or search but merely emphasizes additional deficiencies of the combination of references relied upon by the Examiner.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

March 23, 2007
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